

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 13, 2003 (the "Office Action"). At the time of the Office Action, Claims 1-38 were pending in this patent application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections – 35 U.S.C. §101

The Examiner rejects Claims 1-20 and 31-38 under 35 U.S.C. § 101, asserting that the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner states that these claims "have no connection to the technological arts. None of the steps indicate any connection to a computer or technology." *Office Action*, at page 3. In clarifying his position, the Examiner states that certain steps of the claims may be performed manually by a person. However, even if true, Applicants respectfully submit that this rejection is completely untenable in light of overwhelming statutory and case law. The Manual of Patent Examining Procedure (the "M.P.E.P.") presents and clearly analyzes this legal authority in section 2106. For the sake of convenience, a portion of this section follows, with particularly relevant portions emphasized:

As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). Accordingly, section 101 of title 35, United States Code, provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In *Chakrabarty*, 447 U.S. at 308-309, 206 USPQ at 197, the court stated:

In choosing such expansive terms as "manufacture" and "composition of matter," modified by the comprehensive "any," Congress plainly contemplated that the patent laws would be given wide scope. The relevant legislative history also supports a broad construction. The Patent Act of 1793, authored by Thomas Jefferson, defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof]." Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318. The Act embodied

Jefferson's philosophy that "ingenuity should receive a liberal encouragement." V Writings of Thomas Jefferson, at 75-76. See *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (148 USPQ 459, 462-464) (1966). Subsequent patent statutes in 1836, 1870, and 1874 employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word "art" with "process," but otherwise left Jefferson's language intact. The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to "include anything under the sun that is made by man." S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952). [Footnote omitted]

This perspective has been embraced by the Federal Circuit:

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35. . . . Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.

Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556.

As cast, 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *Warmerdam*, 33 F.3d at 1358, 31 USPQ2d at 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a "useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or

composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.

Manual of Patent Examining Procedure at § 2106 (emphasis added).

Applicants respectfully request the Examiner to review independent Claims 1, 11, and 31 in light of the statutory requirements as outlined above. These claims each clearly present a useful process in the form of a series of steps or acts to be performed, which is specifically identified by statute, case law, and the M.P.E.P. as patentable subject matter under 35 U.S.C. § 101. None of these claims present an abstract idea, a law of nature, or a natural phenomenon. Therefore, Claims 1, 11, and 31 and their respective dependent claims are unmistakably drawn to patentable subject matter. Thus Applicants respectfully request the Examiner to reconsider and withdraw the rejection to these Claims.

Double Patenting

The Examiner has indicated that Claims 1-38 conflict with Claims 1-32 of Application Serial No. 09/470,588. While the claims from the two applications address concepts in a common field of endeavor, Applicants respectfully submit that each of the applications includes claims focused on different and patentably distinct aspects of this field. In accordance with the Examiner's suggestion and the requirements of 37 C.F.R. § 1.78(b) (*see also, M.P.E.P.* § 822), Applicants will maintain a clear demarcation between the applications.

Claim Rejections – 35 U.S.C. §103

The Examiner rejects Claims 1-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,991 to Small ("*Small*") in view of U.S. Patent No. 6,330,544 to Walker et al. ("*Walker*"). Applicants respectfully submit that the *Small-Walker* combination fails to teach or suggest all elements of these claims. For example, Claim 1 recites:

A computer-based interface for facilitating rebate processing, the interface operable to:
receive authorization of a rebate request;

display rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and receive a selection of the disbursement options.

As the primary reference in this rejection, the Examiner cites to *Small*. *Small* discloses an “interactive consumer product promotion method and match game” that, as a small part of its operation, may provide “[c]oupons and/or rebate offers for products [that can be] downloaded for printing by the consumer.” In short, *Small* discloses a bingo game that can bring coupon and rebate information to the attention of a consumer. As teaching for elements of Claim 1, the Examiner references column 7, lines 36-43 of *Small*. This portion of *Small* details how to pay winnings to a bingo game winner. However, this bingo game payment technique fails to teach or suggest any of the elements of Applicants’ Claim 1, such as an interface operable to:

display rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value . . .

As further teaching of elements of Claim 1, the Examiner takes Official Notice of “old and well known” retail incentives. The Examiner states that examples of well known incentive offers include: “quantity discounts where the greater number of like items bought, the greater the percentage of discount received; total purchase discounts where the higher the total purchase price, the higher the discount received; and a variety of rebate offers.” *Office Action*, at page 6. However, despite the opportunity to use his own language to craft what was well known in the art, Applicants respectfully submit that the Examiner has failed to detail any “known” art that shows any elements of Claim 1. The first two statements of the Examiner appear to refer to volume discounts, while the third statement simply makes a vague reference to “a variety of rebate offers.” However, even assuming for arguments sake that these are well known incentives, they fail to teach or suggest a computer-based interface operating to:

display rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value . . .

In support of the Official Notice, the Examiner cites to an article by Connie Guglielmo from *MacWEEK*, October 24, 1989 ("*Guglielmo*"). Applicants respectfully submit that *Guglielmo* also fails to teach or suggest any of the aspects of Claim 1. The portion of *Guglielmo* referenced by the Examiner states:

The "Free Trial Run or Case Back" promotion, which runs until Dec. 31, offers qualified customers buying Apple IIGS, Mac Plus, SE, SE/30 or IICx systems a choice of two plans: either an option to return the hardware by Jan. 15 or \$150 to \$300 in rebates on Apple peripherals (see *MacWEEK*, Sept. 12).

However, this excerpt, as with the Examiner's earlier discussed statements, simply fails to teach or suggest any of the aspects of Claim 1. Moreover, Applicants respectfully submit that the Examiner has employed hindsight reconstruction to combine *Small* and *Guglielmo*. Speculation in hindsight that it would have been obvious to make a proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.¹ and governing Federal Circuit case law.²

¹ See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

As a final ingredient for the combination, the Examiner cites to portions of *Walker*. However, Applicants submit that the combination with *Walker* fails to remedy any of the shortcomings of *Small*. In general, *Walker* discloses techniques for processing “redemption vouchers such as gift certificates that may be issued and used in conjunction with credit cards.” *Walker*, col. 1, lines 19-21. However, *Walker*’s system for distribution and redemption of gift certificates fails to address the operations of a computer-based interface as recited in Claim 1. Therefore, the *Small-Walker* combination fails to teach or suggest all elements of Claim 1. Claims 11, 21, and 31 each include limitations that, for substantially the same reasons as discussed with respect to Claim 1, are not taught or suggested by the *Small-Walker* combination. Moreover, the claims that depend from these independent claims add further patentable limitations that the *Small-Walker* combination fails to teach or suggest. Thus Applicants respectfully request reconsideration and withdrawal of the rejection to Claim 1, 11, 21, and 31. and their respective dependent claims.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Attorneys for Applicants

A handwritten signature in black ink, appearing to read "Kurt M. Pankratz".

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